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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,219	04/26/2001	Shunpei Yamazaki	12732-032001 / US4867	5375
26171	7590	04/13/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				HENNING, MATTHEW T
		ART UNIT		PAPER NUMBER
		2131		

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/842,219	YAMAZAKI ET AL.
	Examiner	Art Unit
	Matthew T. Henning	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 February 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,26,51 and 54-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,26,51 and 54-82 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 April 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

1 This action is in response to the communication filed on 2/6/2006.

2 **DETAILED ACTION**

3 *Response to Arguments*

4 Applicants argue primarily that Li did not disclose connecting to the Internet after the
5 comparison of the biometric tokens. Li states in Col. 6 Lines 15-25 that “[e]xamples of
6 communications (calls) within the context of this invention include...(b) digital transmissions
7 such as packetized messages over a network (LAN, WAN, Internet, etc.)” and further states in
8 Col. 11 Lines 51-56 that “[i]f the tokens match at step 313 but not identically..., the call is
9 authenticated **for connection** at a step 314.” It is further seen in Figs. 3A and 3B that the step of
10 comparing the biometric tokens in the mobile device, step 309, occurs prior to the step of
11 authorizing the call for connection in step 314. As such, it is clear that in the system of Li, for
12 packetized messages over a network, the connection for the call is not created until after the
13 biometric tokens are compared, at which point a connection to the Internet was established for
14 the call, and therefore Li meets the limitations of the claim. Therefore, the examiner does not
15 find the argument persuasive.

16 Applicants further argue that Li was already connected to the Internet prior to the
17 comparison step by pointing out that the device 102 communicated with the CAS 106 through
18 the Internet. First, the examiner points out that there is no limitation in the claim prohibiting
19 multiple connections to the Internet, and as such, if the device was connected to the Internet in
20 order to receive the token from the CAS, it does not mean that the device did not also connect to
21 the Internet for the call once the device was authenticated for connection (as explained above).
22 Further, Li did not require that communications with the CAS be over the Internet but the

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1 communications could have been over a PSTN (See Col. 7 Lines 17-22), and as such, for the
2 embodiments that use the PSTN and not the Internet to communicate with the CAS, this
3 argument does not apply. As such, the examiner does not find the argument persuasive.

4 Claims 1, 26, 51, and 54-82 have been examined. Claims 2-25, 27-50, and 52-53 have
5 been cancelled.

6 All objections and rejections not set forth below have been withdrawn.

7 ***Claim Rejections - 35 USC § 102***

8 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
9 basis for the rejections under this section made in this Office action:

10 *A person shall be entitled to a patent unless -*

11 *(e) the invention was described in (1) an application for patent, published under section
12 122(b), by another filed in the United States before the invention by the applicant for patent or
13 (2) a patent granted on an application for patent by another filed in the United States before the
14 invention by the applicant for patent, except that an international application filed under the
15 treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
16 application filed in the United States only if the international application designated the United
17 States and was published under Article 21(2) of such treaty in the English language.*

18

19 Claims 1, 26, 51, 54-60, and 62-82 are rejected under 35 U.S.C. 102(e) as being
20 anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

21 Regarding claims 1 and 26, Li disclosed a portable communication device having a
22 system for identifying an individual to identify a client (See Li Abstract), said portable
23 communication device comprising: a memory for storing at least one reference biological
24 information of the client (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-
25 27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element
26 417); a checking circuit for checking the read biological information with the stored biological

1 information (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36); a transmitting circuit for
2 transmitting information that the read biological information and the stored biological
3 information have matched to a server in a case where the checking has matched (See Li Fig. 4
4 Elements 402 and 102 and Col. 11 Lines 3-9), wherein the portable communication device is
5 connected to the Internet after the read biological information and the stored biological
6 information have matched (See Li Col. 6 Paragraph 2 and Col. 11 Paragraph 5).

7 Regarding claim 51, Li disclosed a business method using the Internet, said business
8 method comprising: identifying a client by an identifying element loaded in a portable
9 communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a
10 communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a
11 control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying
12 comprises: storing a reference biological information of the client in the portable communication
13 device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines 20-27); reading
14 biological information of the client (See Li. Col. 10 Lines 57-58); checking the read biological
15 information with the reference biological information (See Li Col. 10 Lines 61-65); connecting
16 the portable communication device to the Internet after the read biological information and the
17 stored biological information have matched (See Li Col. 6 Paragraph 2 and Col. 11 Paragraph 5);
18 and transmitting information that the read biological information and the reference biological
19 information have matched from the identifying element to the control element in a case where
20 the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), and
21 wherein said controlling step comprises: admitting the communication between the client and the

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1 plurality of dealers after identifying the client by the identifying element (See Li Col. 11 Lines
2 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56).

3 Regarding claims 54 and 66, Li disclosed that the memory stores a plurality of biological
4 information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph 3 and Col. 10
5 Paragraph 4), and the transmitting circuit transmits information that the read biological
6 information has matched with at least one of the stored plurality of information to the server (See
7 Li Col. 11 Lines 3-9).

8 Regarding claims 55 and 67, Li disclosed that the sensor reads a plurality of biological
9 information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit transmits
10 information that each of the plurality of read biological information has matched with at least
11 one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

12 Regarding claims 56 and 68, Li disclosed that the information that the read biological
13 information and the stored biological information have matched is transmitted to the server
14 through the Internet (See Li Col. 7 Paragraph 2).

15 Regarding claims 57 and 71, Li disclosed that after transmitting information that the
16 checking has matched to the server, a personal identification number information is sent to the
17 Server (See Li Col. 15 Paragraphs 3-4).

18 Regarding claims 58 and 72, Li disclosed that in a case that the personal identification
19 number matches with a number stored at the server, the stored biological information is
20 rewritable (See Li Col. 15 Paragraph 3).

21 Regarding claims 59-60, 73-74, and 78-79, Li disclosed that the biological information is
22 one selected from the group consisting of a fingerprint, a palm pattern and a voice print; and that

1 the palm pattern is a whole pattern of the palm or a pattern of a part of the palm (See Li Col. 6
2 Paragraph 3 and Col. 17 Paragraph 3).

3 Regarding claim 62, Li disclosed that the sensor includes one of a photodiode and a CCD
4 (See Li Col. 4 Paragraph 6).

5 Regarding claims 63-65, 75-77, and 80-82, Li disclosed that the portable communication
6 device comprises a portable information terminal; a portable telephone; a personal computer (See
7 Li Col. 5 Line 66 – Col. 6 Line 14).

8 Regarding claims 69-70, Li disclosed a step of transmitting information that the checking
9 has matched from the server to a connection of the client; and that a transaction is started
10 between the client and the connection after the connection has received information that the
11 checking has matched (See Li Col. 16 Paragraph 2).

12 ***Claim Rejections - 35 USC § 103***

13 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
14 obviousness rejections set forth in this Office action:

15 A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
16 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
17 subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in
18 the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was
19 made.

20
21 Claim-61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li as applied to
22 claim 1 above, and further in view of Osborn (US Patent Number 6,026,293).

23 Li disclosed a memory unit containing programs, responses and any other information the
24 Fingerprint Capturing Module of the cellular phone needed to operate (See Li Col. 12 Lines 20-
25 27), but failed to disclose what type of memory the memory unit was.

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1 Osborn teaches that in cellular telephones, programs are stored in flash memory (See
2 Osborn Col. 3 Line 61 – Col. 4 Line 2).

3 It would have been obvious to the ordinary person skilled in the art at the time of
4 invention to employ the teachings of Osborn in the authenticating cellular telephone of Li by
5 providing the memory unit as a flash memory. This would have been obvious because the
6 ordinary person skilled in the art would have been motivated to store the programs of the phone
7 in the conventional manner.

8 *Conclusion*

9 Claims 1, 26, 51, and 54-82 have been rejected.

10 Applicant's amendment necessitated the new ground(s) of rejection presented in this
11 Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
12 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13 A shortened statutory period for reply to this final action is set to expire THREE
14 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
15 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
16 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
17 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
18 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
19 however, will the statutory period for reply expire later than SIX MONTHS from the date of this
20 final action.

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1 Any inquiry concerning this communication or earlier communications from the
2 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.

3 The examiner can normally be reached on M-F 8-4.

4 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
5 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
6 organization where this application or proceeding is assigned is 571-273-8300.

7 Information regarding the status of an application may be obtained from the Patent
8 Application Information Retrieval (PAIR) system. Status information for published applications
9 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
10 applications is available through Private PAIR only. For more information about the PAIR
11 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
12 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13

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16

17


18 Matthew Henning
19 Assistant Examiner
20 Art Unit 2131
21 4/5/2006

CHRISTOPHER REVAK
PRIMARY EXAMINER

04/09/06